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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/646,975 | 08/22/2003 | Patrick C. Lilley | 14911US02 | 1060 |
| 23446 7590 10/31/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661 | | | EXAMINER WOOD, WILLIAM H | |
| | | | ART UNIT 2193 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,975

Applicant(s)

LILLEY, PATRICK C.

Examiner

William H. Wood

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

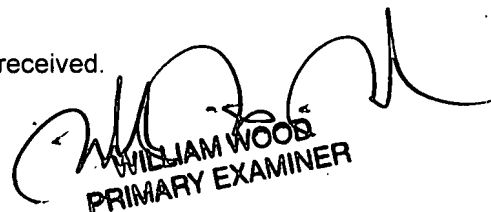
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/17/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____


WILLIAM WOOD
PRIMARY EXAMINER

DETAILED ACTION

Claims 1, 3 and 5-22 are pending and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 September 2007 has been entered.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 17 September 2007 was considered by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3 and 5-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New subject matter not supported in the originally filed disclosure is "when applied by shifting ... before generation of encoded difference information" (claims 1 and 15). The phrase is interpreted, for the purposes of the below novelty rejections, as simply generating an update package before applying the update package. The new matter must be removed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3 and 5-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "more closely aligns " in claims 1 and 15 is a relative term, which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Correction required.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3 and 5-22 are rejected under 35 U.S.C. 102(e) as being anticipated by **O'Neill** (USPN 6,832,373).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 1

O'Neill disclosed a mobile services network comprising:

a mobile electronic device (*figure 1C, element 104; column 7, lines 23-29*);

a management server (*figure 1C, element 132*);

an update package repository (*figure 1C, element 133; column 10, lines 63-64*); and

a generator for generating an update package used in updating firmware in the mobile electronic device from a first version to a second version, the update package comprising encoded difference information and a shift region list that identifies at least one region of the first version of firmware and an associated offset that when applied by shifting the at least one region within the first version of firmware before generation of the encoded difference information produces a modified first version in which the at least one region more closely aligns to a corresponding region of the second version of firmware (*figure 1C, element 102; and column 4, lines 3-13; shift region and offset correspond to O'Neill's use of and instructions for how to use existing code, encoded difference information corresponds to new information that must be added or removed from the original*).

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Claim 3

O'Neill disclosed the network according to claim 2 wherein the update packages are populated into the update package repository (*figure 1C, element 133; column 10, lines 63-64*).

Claim 5

O'Neill disclosed the network according to claim 1 wherein the management server and the update package repository are communicatively coupled (*figure 1C*).

Claim 6

O'Neill disclosed the network according to claim 1 wherein the generator with a partial predictive mapping preprocessor and the update package repository are communicatively coupled (*figure 1C*).

Claim 7

O'Neill disclosed the network according to claim 1 wherein the generator with a partial predictive mapping preprocessor is located at a location remote from the update package repository (*figure 1C*).

Claim 8

O'Neill disclosed the network according to claim 1 wherein the mobile electronic device comprises:

- a non-volatile memory (*column 27, lines 56-59*);
- a random access memory (*column 16, line 4*); and
- security services (*column 7, lines 36-37*).

Claim 9

O'Neill disclosed the network according to claim 8 wherein the non-volatile memory (*figure 8B*) comprises:

- an update agent (*column 4, line 46; column 27, lines 56-59*);
- a firmware and real-time operating system (*column 33, line 33*);
- a download agent (*column 27, lines 56-59*); and
- a boot initialization (*column 28, line 2*).

Claim 10

O'Neill disclosed the network according to claim 9 wherein the non-volatile memory further comprises an operating system layer (*column 33, line 33*).

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Claim 11

O'Neill disclosed the network according to claim 9 wherein the non-volatile memory further comprises an end-user-related data and content unit (*column 7, line 26*).

Claim 12

O'Neill disclosed the network according to claim 9 wherein the mobile electronic device performs the following:

downloading an update package from the update package repository
(*column 16, lines 26-28*);

rebooting (*column 16, line 36*);

executing the boot initialization (*column 16, line 36; column 28, line 2*);

determining whether an update process is needed (*column 9, line 21*); and

invoking the update agent (*column 16, lines 37-39*).

Claim 13

O'Neill disclosed the network according to claim 12 wherein the mobile electronic device determines the need for an update process based on status information (*column 9, line 21*).

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Claim 14

O'Neill disclosed the network according to claim 12 wherein the mobile electronic device invokes the update agent to execute the update process if it is determined an update process is needed (*column 16, lines 37-39*).

Claim 15

O'Neill disclosed a method for generating an update package using an old image and a new image of a firmware (*column 8, lines 7-8*) in a mobile services network, the method comprising:

creating a module map between modules in the old image and modules in the new image of firmware (*column 4, lines 3-13; column 10, lines 65-37*);

creating a module map between modules in the old image and modules in the new image of firmware (*column 4, lines 3-13*);

creating a shift region list (*column 4, lines 3-13*); and

generating an update package using information at least based on the shift region list (*column 4, lines 3-13; additionally note, column 16, line 66 to column 17, line 19*).

Further, refer to above rejection of newly amended claim 1 for corresponding rejections of newly amended limitations of claim 15.

Claim 16

O'Neill disclosed the method according to claim 15 wherein the module map comprises module locations and sizes in the old image of firmware and the new image of firmware (*column 8, lines 33-37; column 19, lines 4-12, reuse and recycle specifically located and sized code/modules*).

Claim 17

O'Neill disclosed the method according to claim 15 wherein creating the shift region list comprises:

identifying shift points within each module of the firmware, wherein the shift points define shift regions (*column 19, lines 30-41*);

creating a first shift region list (*column 19, lines 30-41*);

modifying the first shift region list to include external shifts (*column 19, line 63 to column 20, line 5, different sections of the memory or storage*); and

creating a second shift region list (*column 19, lines 53-58*);

Claim 18

O'Neill disclosed the method according to claim 17 wherein the method further comprises consolidating adjacent shift regions having identical address adjustments (*column 20, lines 5-15*).

Claim 19

O'Neill disclosed the method according to claim 17 wherein the first shift regions list comprises:

shift regions correspond to modules in the old image of firmware (*column 19, line 6, "existing code version"*);

sizes of the shift regions (*column 19, lines 30-41*); and

adjustment values correspond to the difference between a start location of a module in the old image of firmware and the start location of the same module in the new image of firmware (*column 20, lines 60-64*).

Claim 20

O'Neill disclosed the method according to claim 19 wherein modifying the first shift region list comprises:

finding modules that changed size from the old image of firmware to the new image of firmware (*column 20, lines 36-41*);

adjusting address-based instructions in the old image of firmware using the adjustment value of the changed modules (*column 20, lines 36-41; column 20, lines 52-53*);

identifying areas where new content was inserted into a module (*column 24, lines 37-63, DEF instruction*);

defining the identified areas of new content as new shift regions (*column 24, lines 37-63, DEF instruction*);

deleting the changed modules from the first shift list (*column 24, lines 37-63, DEF instruction*); and

inserting the defined shift regions into the first shift list (*column 24, lines 37-63, DEF instruction; column 23, line 38 to column 24, line 36, HSH instruction*).

Claim 21

O'Neill disclosed the method according to claim 18 wherein adjacent shift regions are consolidated if modules remain unchanged in the new image from the old image (*column 20, lines 11-15*).

Claim 22

O'Neill disclosed the method according to claim 18 wherein the second shift region list is the result of consolidating shift regions in the modified first shift region list (*column 19, lines 53-58*).

Response to Arguments

7. Applicant's arguments filed 08 May 2007 have been fully considered but they are not persuasive. Applicant argues **O'Neill** fails to disclose "...creating a module map between modules in the old image and modules in the new image of firmware; ... making use of an offset or alignment. These arguments are not persuasive.

First, **O'Neill** disclosed modules and image through (column 4, lines 3-13; column 16, lines 26-31; column 16, line 66 to column 17, line 19). The cited prior art indicates mapping small sections or modules from a larger sequence or image of code. First and second sequences correspond to old and new. Firmware is specifically indicated in column 8, lines 7-8. Mapping the sequences is the "creating a shift region list". The "instruction set" of **O'Neill** describes the mapping or shifting of existing code/modules into the new updated image or sequence.

Second, the offset and alignment of the two versions is clearly indicated by **O'Neill** at column 4, lines 3-13. If previously existing code portions are to be used, they must be offset and aligned (offset and alignment merely referring to encoding to use the previous portions in a new way or with the new portions) to the new version as appropriate.

Having addressed applicant's concerns the rejections are maintained.

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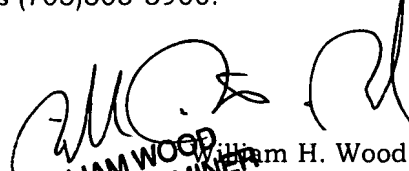
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 10:00am - 4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571)-272-3756. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.


WILLIAM WOOD William H. Wood
PRIMARY EXAMINER Patent Examiner
AU 2193
October 27, 2007